

**IN THE MATTER OF AN OPPOSITION
by UMA Group Ltd. to application No.
1,107,222 for the trade-mark UMA in the
name of CIBA Specialty Chemicals Holding
Inc.**

On June 21, 2001, CIBA Specialty Chemicals Holding Inc. (the “Applicant”) filed an application to register the trade-mark UMA (the “Mark”) based upon proposed use of the Mark in Canada. The current statement of wares and services in the application reads:

Wares:

(1) Chemical products used in industry and science, namely flocculants, coagulants, thickeners, sedimentation reactants, colloidal reactants, polyelectrolytes (anionic and cationic), aggregants, purifiers and clarifiers.

Services:

(1) Treatment of materials, namely mineral processing, filtration, thickening, sedimentation systems, colloidal systems, sludge systems, centrifugation, flocculation, aggregation, purification, clarification, coagulation, dewatering, chemical design/formation/manufacture, molecular design/formation/manufacture, polymer design/formation/manufacture.

The application was advertised for opposition purposes in the Trade-marks Journal of May 7, 2003. On January 7, 2004, UMA Group Ltd., (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement.

The Opponent filed the affidavits of Jeremy O’Neil Kon, Catherine Rodgers and Karen E. Thompson in support of its opposition.

The Applicant elected to not file any evidence in support of its application and did not seek to cross-examine any of the Opponent’s affiants.

Only the Opponent filed a written argument; an oral hearing was not requested.

Grounds of Opposition

The grounds of opposition all turn on the issue of the likelihood of confusion between the Mark and UMA trade-marks and trade-names registered and/or used by the Opponent.

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [See *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

1. Registrability under Section 12(1)(d)

The Opponent pleads that the Mark is not registrable because it is confusing with the following registered marks:

- UMA registered under No. 189,944
- UMA Design registered under No. 325,818
- THE UMA GROUP registered under No. 190,429

Each of these three marks is registered for (1) Consultant and engineering services relating to transportation, municipal engineering, photogrammetry, planning, project management, industrial-commercial, land development, northern development, water resources, pollution control, earth sciences, namely, evaluation of soil and rock properties for engineering purposes, geotechnical services and laboratories facilities for testing materials particularly in the areas of ground water development, construction materials searches, mineral exploration and development; and surveying. (2) Consulting and engineering services relating to urban development, industrial engineering, construction management, facilities management, geographic information services, irrigation, environmental engineering and hydrocarbon process engineering. (3) Construction contracting services. (4) Metal fabrication services.

The Opponent has satisfied its initial burden under s. 12(1)(d) by providing copies of the above registrations [see Thompson affidavit].

The material date with respect to this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

Since the mark that is the subject of registration No. 189,944 is identical to the Mark, I will begin by focussing on it.

the test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

In two recent decisions, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321, [2006] 1 S.C.R. 772, and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824, the Supreme Court of Canada discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing. It is with these general principles in mind that I shall review the pertinent evidence and assess each relevant factor identified above.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

Both marks are inherently weak since trade-marks comprised solely of initials are inherently weak. [*GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.)]

There is no evidence that the Applicant's Mark has become known to any extent. In contrast, Mr. Kon (the Opponent's Chairman) has provided evidence that the Opponent's UMA mark has been used and promoted in Canada from as early as 1995.

This factor clearly favours the Opponent.

s. 6(5)(b) - the length of time each trade-mark has been in use

This factor also favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

At paragraph 4 of his affidavit, Mr. Kon describes the Opponent's business as follows: "The Opponent provides consulting, planning, design, engineering, construction and management services to the community infrastructure, earth and water, transportation, and industrial market sectors with activities in Canada, the United States and Mexico. At paragraph 8, he sets out some of the Opponent's clients, which include the City of Edmonton, the Town of Peace River, Shell Canada, CN Environmental, Public Works & Government Services Canada, Alberta Energy Corporation, Little Black River First Nation, TVX Gold and High River Mining, Sheritt Gordon Mines, Potash Corp. of Saskatchewan, Cardinal River Coals Ltd. and Canadian Bechtel Ltd. The projects undertaken for these clients related to wastewater treatment plants, sludge handling facilities, sludge dewatering facilities, chemical processing of gold ore, and tailings disposal, among others.

The only information that we have concerning the Applicant's activities is provided by the Opponent's affiant, Ms. Rodgers. Ms. Rodgers, an assistant to the Opponent's trade-mark agent, provides as Exhibit 1 "a copy of a letter dated December 15, 2003 from Smart & Biggar, trade-mark agent for the applicant in this proceeding, together with copies of the enclosures referred to

therein.” The enclosures comprise printed materials of the Applicant entitled “Case Study UMA Technology”, “Ciba MAGNAFLOC 3230 Polymers by Design”, and “Product Specifications for Ciba MAGNAFLOC 3230 and Ciba ZETAG 8660 Flocculant”. These materials indicate that the Applicant’s UMA approach “directly leads to a preferred floc structure and better dewaterability of sludges.” Moreover, the materials state that the Applicant’s UMA approach “can be used in a variety of industries: municipal sewage & potable, paper, textile, petrochemical/chemical, pharmaceutical and food/agriculture”. The Applicant’s brochures set out a number of case studies, including ones directed to a coal preparation plant, a sand and gravel quarry, and the sedimentation of a pre-leach gold ore.

There therefore appears to be an overlap between the parties’ services and target clientele, resulting in this factor favouring the Opponent.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

Although the Opponent’s UMA mark appears to relate to its original corporate name, Underwood, McLellan and Associates Limited, that name has not been used since 1978 and therefore it seems unlikely that current clients would associate such words with the Opponent’s mark.

The Applicant’s brochures reveal that its UMA Mark stands for “unique molecular architecture” but it is difficult to assess to what extent this idea is associated with the Mark.

Overall, given that the marks are identical, this factor also favours the Opponent.

conclusion re confusion

Even though marks comprised of initials are typically only entitled to a narrow scope of protection, I find that the Applicant’s Mark falls within the scope of protection to which the Opponent’s UMA mark is entitled. After all, the marks are identical, their applications and target clientele overlap, and the Applicant has not introduced any evidence.

The. 12(1)(d) ground of opposition accordingly succeeds based on registration No. 189,944.

The UMA Design mark registered under No. 325,818 is shown below:



The evidence with respect to this mark is essentially the same as that with respect to the Opponent's UMA mark and I find that the s. 12(1)(d) ground also succeeds based on registration No. 325,818.

2. Entitlement under Section 16(3)(a)

The Opponent pleads that the Applicant is not the person entitled to register the Mark because, at the date of filing of the application, the Mark was confusing with the Opponent's registered marks, which the Opponent had previously used in Canada in association with the registered services and which the Opponent had not abandoned at the date of advertisement of the Applicant's application.

The Opponent has an initial burden to show that it had in fact used its marks as claimed in this pleading. Mr. Kon's evidence satisfies the Opponent's initial burden with respect to both the marks UMA and UMA Design.

The Applicant has not filed evidence or argument in support of its application. Although the material date with respect to this ground is earlier than with respect to the registrability ground, the analysis of the likelihood of confusion is essentially the same. Accordingly for similar reasons, I find that the Applicant has not met its legal burden with respect to this ground, with the result that the s. 16(3)(a) ground succeeds based on each of the Opponent's marks UMA and UMA Design.

3. Remaining Grounds

As I have already refused the application on multiple grounds, I will not address the remaining grounds of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 9th DAY OF MAY 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board